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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,363	11/22/2000	Jari Suutarinen	796.377USW1	6589

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EXAMINER

LEE, JOHN J

ART UNIT	PAPER NUMBER
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2684

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/721,363

Applicant(s)

SUUTARINEN, JARI

Examiner

JOHN J LEE

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's arguments with respect to claims 1 – 15 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. **Claims 1-3 and 5-15** are rejected under 35 U.S.C. 102(e) as being anticipated by Foti (US Patent number 5,974,309).

Regarding **claim 1**, Foti discloses that a method of trace activation in a communications system (Fig. 1 and abstract), wherein a mobile station (14 in Fig. 1) is in communication with a mobile communications network (Fig. 1). Foti teaches that directing a communication from the mobile station (14 in Fig. 1) to a predefined trace activation number (particular directory number of called party (calling line

identification)) of tracing facility (28 in Fig. 1) (column 3, lines 9 – 44, abstract, and Fig. 1 where teaches that the call is assumed to have been dialed to the directory telephone number (calling line identification) of the called mobile station subscriber). Foti teaches that activating tracing at the tracing facility (28 in Fig. 1) for the mobile station from which the communication originates (column 3, lines 9 – 44, abstract, and Fig. 1 where teaches assuming that a cellular call originates with a calling party A and dialed to the directory telephone number (B party-number) of the called mobile station, and home database is queried with the dialed B-number to determine called subscriber location, and then activates tracing/monitoring the call). Foti also teaches that generating a trace report (print (32) in Fig.1) for the mobile station (Fig. 2 and column 3, lines 58 – column 4, lines 30).

Regarding **claim 2**, Foti discloses all the limitation, as discussed in claim 1. Furthermore, Foti further discloses that deactivating tracing when the call is ended (Fig. 2 and column 4, lines 52 – 65 where teaches law enforcement agency monitors the voice communication and network data for the call, regarding the deactivating monitoring as call is ended).

Regarding **claim 3**, Foti discloses that the directed communication is a message (particular directory number of called party) from the mobile station (column 3, lines 9 – 44, abstract, and Fig. 1).

Regarding **claim 5**, Foti discloses that deactivating tracing when a second message from the mobile station is directed to the predefined trace activation number (column 3, lines 9 – 44, abstract, and Fig. 1).

Regarding **claim 6**, Foti discloses all the limitation, as discussed in claim 1.

Regarding **claim 7**, Foti discloses all the limitation, as discussed in claims 1 and

2.

Regarding **claim 8**, Foti discloses that the communication is forwarded to the predefined trace activation number (column 3, lines 9 – 44, abstract, and Fig. 1 where teaches home database is queried the directory number to determine whether monitor or not, and if the number is identified, forwards the call to monitoring center).

Regarding **claim 9**, Foti discloses that tracing is activated and deactivated automatically at the switching center (column 3, lines 9 – 44, abstract, and Fig. 1 where teaches home database in switching network is queried the directory number to determine whether monitor or not, tracing activation or not).

Regarding **claim 10**, Foti discloses all the limitation, as discussed in claim 1.

Regarding **claim 11**, Foti discloses that equipment (recorded for future use by tape recorder) tracing is activated for the mobile station (column 4, lines 31 – 65 and Fig. 2).

Regarding **claim 12**, Foti discloses all the limitation, as discussed in claim 1.

Furthermore, Foti further discloses that a communications network with which said at least one mobile station (14 in Fig. 1) is arranged to communicate (Fig. 1 and abstract).

Regarding **claim 13**, Foti discloses all the limitation, as discussed in claims 1 and

12.

Regarding **claim 14**, Foti discloses that recording all information available to a network concerning a call path (calling line identification), including internal messages (call information) of the network (column 4, lines 31 – 65 and Fig. 2).

Regarding **claim 15**, Foti discloses all the limitation, as discussed in claims 1 and 14.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Foti in view of Emery et al. (US Patent number 5,727,057).

Regarding **claim 4**, Foti does not specifically disclose the limitation “deactivating tracing when a preset time period is elapsed”. However, Emery discloses the limitation “deactivating tracing when a preset time period is elapsed” (Fig. 7 and column 14, lines 42 – column 15, lines 23 where teaches terminating the trace condition based upon timed decision). It would have been obvious to one having ordinary skill in the art, at the time the invention was made to modify Foti system as taught by Emery. The motivations do so would be to improve efficient call monitoring method and enhancing monitoring system in mobile communication system.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

LaDue (US Patent number 5,889,474) discloses Transmitting Subject Status Information Over a Wireless Communications Network.

Sheffield (US Patent number 6,603,966) discloses Optimizing Performance of a Mobile Communication System.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-6606 (for informal or draft communications, please label
"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John J. Lee** whose telephone number is **(703) 306-5936**. He can normally be reached Monday-Thursday and alternate Fridays from 8:30am-5:00 pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, **Nay Aung Maung**, can be reached on **(703) 308-7745**. Any inquiry of a general nature or

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relating to the status of this application should be directed to the Group receptionist,
whose telephone number is (703) 305-4700.

J.L.
November 18, 2003

A handwritten signature in black ink, appearing to read "John J Lee", with a long horizontal flourish extending to the right.

John J Lee